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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,711	03/20/2000	GAKU HARADA	PF-2554	5841

466 7590 03/04/2002

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EXAMINER

CHANEY, CAROL DIANE

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 03/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

53

Office Action Summary

Application No.

09/528,711

Applicant(s)

HARADA ET AL.

Examiner

Carol Chaney

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 7-10, 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-6, 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

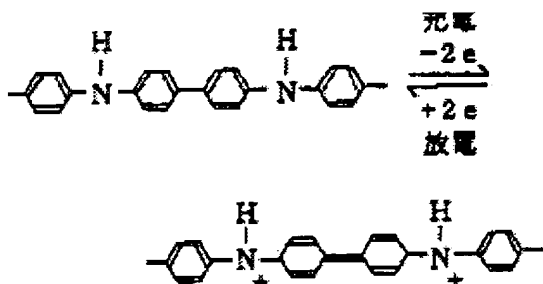
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirai et al., JP 61 206170.

Hirai et al. disclose secondary batteries using poly(diphenylamine) electrodes.

An exemplary electrode material is given by:



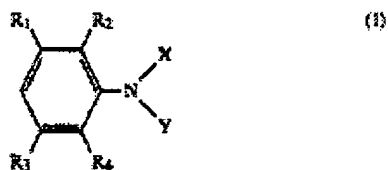
Thus, applicants' claims are anticipated.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al., US Patent 4,740,436 for reasons of record. for convenience, the rejection of 10-3-01 is provided below:

Kobayashi et al. disclose non-aqueous secondary batteries containing a polymer of aniline derivative as a positive electrode. A monomer of the form



where X and Y independently represent a hydrogen atom or a phenyl group. The polymer is formed as a film (column 10, line 49) and during the polymerization process is doped with acid, such as HCl. (Note column 10, lines 30-49.)

The disclosure of Kobayashi et al. differs from applicants' invention in that Kobayashi et al. do not explicitly recite the polymer polybiphenylaniline. However, for the case where either X or Y is phenyl, and the other of X and Y is hydrogen, one of ordinary skill in the art would understand applicants' electroactive material to be disclosed.

Response to Arguments

Applicant's arguments filed 1-3-02 have been fully considered but they are not persuasive. Applicant argues that because Kobayashi does not disclose an example using poly(diphenylamine) as a cathode material, one of ordinary skill in the art would not be motivated to choose diphenylamine, and one of ordinary skill in the art would not be motivated to choose a homopolymer of the diphenylamine. However, Kobayashi et al. list diphenylamine as a "typical example", and teach both homopolymers and copolymers are encompassed by their disclosure. Thus, one of ordinary skill in the art would recognize poly(diphenylamine) as one of a relatively small number of polymers intended to be encompassed by the Kobayashi et al. invention, even if it is not used in specific examples. The disclosure of a reference is not limited to the disclosure's specific illustrative examples, but must be considered as a whole to ascertain what would be realistically suggested to one of ordinary skill in the art. See, for example, *In re Uhlig*, 153 USPQ 460 (CCPA 1967).

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol Chaney whose telephone number is (703) 305-3777. The examiner can normally be reached on Monday-Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, may be reached at the telephone number (703) 308-0756. The official fax numbers for the organization where this application or proceeding is assigned are:

703-872-9310 (non-after finals)

703-872-9311 (after-final)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Carol Chaney
Primary Examiner
Art Unit 1745
February 28, 2002